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**BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES**

Application Number: 10/088,682
Filing Date: July 09, 2002
Appellant(s): EMMERINK ET AL.

Kevin R. Spivak
For Appellant

**EXAMINER'S ANSWER**

This is in response to the appeal brief filed May 7, 2008 appealing from the Office action mailed July 5, 2007.

**(1) Real Party in Interest**

A statement identifying by name the real party in interest is contained in the brief.

**(2) Related Appeals and Interferences**

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

**(3) Status of Claims**

The statement of the status of claims contained in the brief is correct.

**(4) Status of Amendments After Final**

The appellant's statement of the status of amendments after final rejection contained in the brief is correct. However, no copy of Non-Final Office Action is attached and there is no Exhibit 'C' as stated by appellant.

**(5) Summary of Claimed Subject Matter**

The summary of claimed subject matter contained in the brief is correct.

**(6) Grounds of Rejection to be Reviewed on Appeal**

The appellant's statement of the grounds of rejection to be reviewed on appeal is correct.

**(7) Claims Appendix**

The copy of the appealed claims contained in the Appendix to the brief is correct.

**(8) Evidence Relied Upon**

6,757,823 RAO et al 6-2004

**(9) Grounds of Rejection**

The following ground(s) of rejection are applicable to the appealed claims:

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Claims 1, 2, 5, 10-15 and 19-21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Shiomoto et al (US006731628B1) in view of Rao et al (US006757823B1).

Regarding claims 1 and 10, Shiomoto discloses providing a communications link (Fig. 1) between at least two local devices TE-1, TE-2 in a transport network by local switching (LS) centers associated with the local devices (TE);

using a connection information item defining a timeslot connection (see abstract, col 2 lines 10-20, 40-50, timeslot information is created to define the routing of packets which is the information item for connection of the link.) via a switching matrix representing a first control information item; and providing a protocol information item representing a second control information item for the central control device and/or for the local devices to select communications protocols to be used and useable transport

media (The header of the packet contains IP protocol information that contains the packet routing information, see claim 1.)

Shiomoto fails to disclose communications system setup and/or disconnect of communications link.

Rao discloses a method of providing secure signaling connections for packet data network telephony calls (see Fig. 3 and col 1 line 65 – col 2 line 5. Call setup is performed between H.323 devices such as phones and protocol conversion control performed via the H.323 gateways (Fig. 1). Rao dislcoes a simplified and secure call setup and tear down procedure for voice and data communications amongst different devices within an IP telephony network.

Thus it would have been obvious at the time the invention was made to incorporate the teachings of Rao within Shiomoto so as to provide a simplified and secure call setup and tear down procedure for voice and data communications amongst different devices within an IP telephony network.

Regarding claims 2 and 11, Shiomoto discloses media information via the routing tables (see col 3 lines 40-50.) used by the local and transit switches to route packets from source to destination.

Regarding claim 5, Shiomoto discloses the information item (see abstract) as the timeslot connection information is provided to the LS and TS switches accordingly.

Regarding claims 12 and 13, Shiomoto discloses devices may be arranged centrally and/or locally in the area of the first device (see Fig. 1).

Regarding claims 14, Rao discloses conversion devices (Gateways see Fig. 1).

Regarding claims 15, Shiomoto discloses a general circuit switched network. The use of an Ethernet connection is inherent to the network as TE devices are shown in Fig. 1.

Regarding claims 19-21, Shiomoto and Rao disclose an integrated communications IP telephony system with a PC (Fig. 1 of Shiomoto) or a telephone (Fig. 1 of Rao) accordingly.

***Allowable Subject Matter***

Claims 3, 4, 6-9, 16-18 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

**(10) Response to Argument**

With respect to claim 1, applicant contends the cited references fail to teach "communications system setup and/or disconnect of communications link".

The examiner respectfully disagrees, while Shiomoto does not disclose this limitation, Rao cures this deficiency. Rao discloses a method of providing secure signaling connections for packet data network telephony calls (see Fig. 3 and col 1 line 65 – col 2 line 5. Call setup is performed between H.323 devices such as phones and protocol conversion control performed via the H.323 gateways (Fig. 1). *H.323 is an ITU standard defining a set of call control, channel setup, and codec specifications for transmitting real-time audio and video over packet data networks, (col 2 lines 58-61)*

emphasis added. The H.323 gateway serves as the "device" by which the "controlling" functionality of the H.323 protocol is achieved. Thus Shiomoto in combination with Rao clearly discloses the cited limitation of applicant's claims and therefore the rejection to claim 1 is sustained.

With respect to motivation for combining, Examiner believes the motivation to be proper and therefore disagrees with the applicant. According to MPEP 2144 [R-5] here in part;

> *"The reason or motivation to modify the reference may often suggest what the inventor has done, but for a different purpose or to solve a different problem. It is not necessary that the prior art suggest the combination to achieve the same advantage or result discovered by applicant (emphasis added)."*

Thus again the examiner fully believes that the reasons for combining are valid since it improves network efficiency and therefore improving overall network performance as well. Thus the motivation is valid and therefore the rejection to claim 1 is sustained.

Applicant further contends here in part:

"…..applicants submit that one of ordinary skill in the art would not have been motivated to modify Shiomoto in view of Rao because Rao teaches a setup method for secure communications. This requires steps beyond simple setup steps, which leads to overhead. …..Shiomoto makes it abundantly clear that overhead is a drawback and undesirable ."

The Examiner failed to find where Shiomoto discloses "overhead is a drawback and undesirable" in sharp contrast Shiomoto explicitly states (col 2 lines 3-7)

*A unique feature of the present invention is that it adds a* ***further header to a packet which already has a header (emphasis added)*** *in which an IP address has been written, and thereby transfers the packet to the desired destination terminal via an STM network.*

This additional header allows for dynamic and efficient routing that does not restrict specific beginning and end points of routers, rather to reach its destination via any available routers within a network (col 2 lines 19-22). The additional header is interpreted to be an overhead, however, it is not undesirable (as applicant contends) rather prevents packet loss and jitter due to router overload by providing an alternate route to its destination. Thus base on above reasoning Examiner asserts that 1)Shiomoto does not teach away from overhead rather it embraces it within its invention (again col 2 lines 3-22), and 2) incorporating encryption within Shiomoto would enhance the Shiomoto communications system by providing a secure transmission system and deter away from such incorporation.

Thus based on above reasoning, the rejection under 35 U.S.C. 103(a) as being unpatentable over Shiomoto et al in view of Rao et al fully discloses all limitations of applicant's claim 1 and therefore the rejection is to claim is sustained.

Claim 10 for same reasons as claim 1 is also not patentable. The remaining claims are either properly rejected due to their respective dependencies or allowed stated.

**(11) Related Proceeding(s) Appendix**

No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

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